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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/774,792	02/09/2004	Richard H. Kim	328p-Kim	9039

7590 08/25/2004

Barber Legal  
P.O. Box 16220  
Golden, CO 80402-6004

EXAMINER
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ELKINS, GARY E

ART UNIT	PAPER NUMBER
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3727

DATE MAILED: 08/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/774,792

Applicant(s)

KIM ET AL.

Examiner

Gary E. Elkins

Art Unit

3727

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. ____.  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>20040209</u> .  | 6) <input type="checkbox"/> Other: ____.                                    |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. Claim 17 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The phrase “suppressed” with respect to the fold lines is not understood. The specification defines a suppressed fold line as a fold line which has not actually been “expressed” upon the blank. The specification does not define what actually constitutes this “fold line”. A fold line is a line which allows easier bending or folding of the material. As such, it must comprise structure formed within the material. The definition that the fold line has not been “expressed” therefor appears to be contrary to the meaning of the terms “fold line”. How this line is “suppressed” is not understood from the description.
2. Claim 17 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification lacks enablement with respect to the formation of a “suppressed” fold line since the specification fails to define how one is to make and/or use this fold line.
3. Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-18 are unclear with respect to what is being claimed. Claim 1, line 9 positively recites perforation lines within the claimed template. However, in claim 1, lines 12, 16 and 20, "when....perforated", claims 2 and 3, line 2, "allowing...perforating" and claim 10, "for....perforating" imply that the perforation lines have not yet been formed. The claims should be made clear as to whether an indicia or marking line to indicate where a fold line or perforation line is to be formed or an actual fold line or perforation line (or both) is being claimed.

In each of claims 1, 19 and 20, "for folding into variously dimensioned containers" is unclear since only a single template is being claimed, i.e. a single template, as best understood from the disclosure, is formed into a single container. What appears to be a choice is what dimensions the single container is to have.

The following are each a double inclusion of an element, i.e. the element is being reintroduced into the claims: claim 1, lines 8-10, "adjoining panels", "at least one panel" and "at least one fold line", claim 9, "a given perforation line", claim 18, line 1, "perforation line", claim 19, lines 7-9, "adjoining panels", "at least one panel" and "at least one fold line" and claim 20, lines 7-9, same as claim 19.

The following each lack antecedent basis in the claims, i.e. each is only inferentially set forth: claim 6, line 2, "the steps", claim 7, same, claim 9, "the time of folding", claim 10, "the final box" (two occurrences), claim 14, "the parallel fold lines" and claim 16, "the parallel horizontal fold lines" and "the parallel vertical fold lines".

In each of claims 8 and 20, "(valley folded)" is unclear whether the phrase constitutes a limitation in the claim or not.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 19 and 20 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Kim et al '818 or Kim et al '901.

***Allowable Subject Matter***

6. Claims 1-16 and 18, as best understood in view of paragraph 3 above, would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action. It is noted that the indication of allowable subject matter is based upon the fact that claim 1 positively sets forth the fold lines and perforation lines in combination with three sets of indicia associated with the fold lines and perforations.

***Conclusion***

The remaining cited prior art is illustrative of various variable volume boxes which include multiple alternative fold lines and perforation lines used to make a box with a choice of size.

In order to reduce pendency and avoid potential delays, Technology Center 3700 is encouraging FAXing of responses in Office Actions to (703)872-9306. This practice may be used for filing papers not requiring a fee. It may also be used for filing papers which require a fee by Applicants who authorize charges to a PTO deposit account. Please identify the Examiner and art unit at the top of your cover sheet.

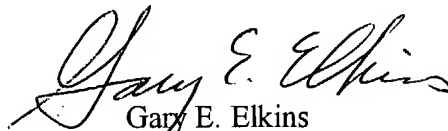
Art Unit: 3727

If in receiving this Office Action, it is apparent that certain documents are missing, e.g. copies of references cited, form PTO-892, etc., requests for copies of such papers should be directed to Errica Bembry at (703)306-4005.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist at (703)308-1078.

Any inquiry concerning this communication or earlier communication from the Examiner should be directed to Gary Elkins at telephone number (703)308-1034. The Examiner can normally be reached Monday, Tuesday and Thursday.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Mr. Lee Young can be reached at (703)308-2572.

  
Gary E. Elkins  
Primary Examiner  
Art Unit 3727

gee  
23 August 2004